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JUL 23 2009

OFFICE OF PETITIONS

Patent No. 7,004,350 :
Issue Date: February 28, 2006 :
Application No. 10/801,194 :
Filed: March 15, 2004 :

LETTER

This is in reply to the communications filed April 23, 2009, February 24, 2009, January 31, 2008 and October 27, 2006, which was supplemented on January 31, 2008, respectively petitioning the Director to expunge a Certificate of Correction for U.S. Patent No. 7,004,350, add Harris Cohen as an inventor in U.S. Patent No. 7,004,350, expunge assignment records in U.S. Patent No. 7,004,350, and deny a petition to correct inventorship filed on September 26, 2006 by Amity Rubberized Pen Company.

As a third party to an *ex parte* proceeding, petitioner is not in a position to demand that the USPTO act to vacate a prior decision or act as requested unless specifically authorized by statute or regulation. In particular, neither the patent statute nor its implementing regulation confer a right upon a third party to intervene or otherwise challenge the Office's decisions on the matters raised in the petitions. Information submitted to the Office regarding a patent that is not in reexamination must be consistent with 35 USC § 301, 37 CFR §§ 1.322 or 1.501, and/or the standards discussed in MPEP § 2207. The actions requested by the third party here are not specifically authorized by statute or regulation, and the communication is not a proper submission under 35 USC § 301, 37 CFR §§ 1.322 or 1.501, and/or the standards discussed in MPEP § 2207. Since petitioner lacks standing, the Office will not act as requested.

In addition, the Office's refusal to act on petitioner's requests is consistent with well-established case law for third party filings. See, Hallmark Cards Inc. v. Lehman, 959 F.Supp. 539, 42 USPQ2d 1134 (D.D.C. 1997) (third party lacked jurisdiction and standing to challenge USPTO's issuance of a Certificate of Correction); Hitachi Metals Ltd. v. Quigg, 776 F.Supp 3, 20 USPQ2d 1920, (Fed. Cir. 1989) (third party lacked jurisdiction and standing to overturn USPTO decision to grant a reissue patent); Syntex v. United States Patent and Trademark Office, 882 F.2d 1570, 11 USPQ2d 1866, (Fed. Cir. 1989) (third party requester lacked standing to overturn USPTO decision to issue a reexamination certificate); The Boeing Company v. Commissioner of Patents and Trademarks, 853 F.2d 878, 7 USPQ2d 1487 (Fed. Cir. 1988) (third party requester lacked standing to intervene in district court proceeding stemming from USPTO reexamination decision).

Rather than pursue relief by petition to the USPTO, petitioner's recourse is to challenge the patent itself as a defense if sued for infringement of the '350 patent. Hallmark Cards, 959 F. Supp. at 543. Furthermore, as a defense, petitioner may raise allegations of enforceability "on the basis of ... inequitable conduct." Hitachi, 776 F.Supp. at 10.

The third party communications filed April 23, 2009, February 24, 2009, January 31, 2008 and October 27, 2006 will not be made of record in the file of the above cited application. Accordingly, the third party communications filed April 23, 2009, February 24, 2009, January 31, 2008 and October 27, 2006 will be closed in the Office's Image File Wrapper (IFW) records for the above identified application.

Also, any petition fees already paid by the third party petitioner will be refunded.



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Office of Petitions

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